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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,143	09/24/2001	Brenda F. Baker	RTS-0266	5066
35807	7590	08/31/2004	EXAMINER	
FENWICK & WEST LLP 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94014			SCHULTZ, JAMES	
			ART UNIT	PAPER NUMBER
			1635	

DATE MAILED: 08/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/960,143

Applicant(s)

BAKER ET AL.

Examiner

J. D. Schultz, Ph.D.

Art Unit

1635

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED August 16, 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☒ Newly proposed or amended claim(s) 28-38 would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 28-38.Claim(s) objected to: 21, for depending from rejected claim 2. The claim would be allowable if non-elected subject matter were canceled.Claim(s) rejected: 1, 2, 4-15 and 21, for the same reasons of record as cited in the rejection mailed June 14, 2004.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See Continuation Sheet

Continuation of 3. Applicant's reply and affidavit has overcome the following rejection(s): claims 1, 2, and 11 under 35 U.S.C. §102(b)/103(a), because the oligo of the cited prior art does not hybridize with the recited target region of SEQ ID NO: 3.

Continuation of 5. does NOT place the application in condition for allowance because: applicant's arguments are not considered convincing in regards to the rejection under 35 U.S.C. § 102(b) over Nyce, because the reasons cited therein are insufficient to obviate the pending anticipation and obviousness rejections. In regards to the rejection under 35 U.S.C. § 102(b), applicant has not disputed whether Nyce teaches an oligo that targets the claimed region, but rather indicates that the reference does not provide discussion on the binding or inhibitory activity of the Nyce oligo. Applicant asserts that "nowhere does Nyce does not disclose antisense inhibition of IL-8 using any oligonucleotide. This is not considered convincing, because data describing the inhibitory capacity of the oligo is not required to establish the oligo as an antisense oligo. Nyce clearly indicates that the oligo is an oligo designed for the inhibition of IL-8, contrary to applicant's assertions, for example, on page 21, which introduces the uses of the antisense oligos which follow, including the anticipatory oligo of Nyce. If applicant is alleging that the reference of Nyce is non-enabling, this should be stated on the record followed by the proper analysis. See M.P.E.P. 2121:

"PRIOR ART IS PRESUMED TO BE OPERABLE/ ENABLING

When the reference relied on expressly anticipates or makes obvious all of the elements of the claimed invention, the reference is presumed to be operable. Once such a reference is found, the burden is on applicant to provide facts rebutting the presumption of operability. In re Sasse, 629 F.2d 675, 207 USPQ 107 (CCPA 1980). See also MPEP § 716.07".

Applicant has merely argued that the oligo of Nyce is not enabled, and has not supplied any facts thereto as required. Thus, applicant has not met the burden of showing this reference is lacking enablement, and the rejection is maintained. The same position is taken in the rejection of claims under 35 U.S.C. § 103(a); applicant has argued but has not provided any facts in asserting that either Taylor, a peer reviewed reference, nor Baracchini, an issued patent, are non-enabled. Mere assertions regarding the enablement of these references are not considered convincing.

Continuation of 10. Other: For the record, applicant is correct in noting that claim 21 recites the elected SEQ ID NO: 58, not claim 28 as stated in the final rejection of June 14, 2004, and that said sequence should not have been included in the list of withdrawn sequences resulting from the restriction requirement made final in the action of June 14, 2004. Applicants are also notified that the rejection over Nyce was set forth as a rejection under 35 U.S.C. § 102(b), not 35 U.S.C. § 102(a) as indicated in applicant's after final response of August 16, 2004. Finally, claims 1, 2, and 11 were rejected under 35 U.S.C. § 102(a)/103(a), and not under 102(b)/103(a) as indicated by applicant.

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